No. 07-1070

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IN THE

Supreme Court of the United States

ORMCO CORPORATION,

Petitioner,

v.

ALIGN TECHNOLOGY, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

DANIEL J. FURNISS
Counsel of Record
ANNE M. ROGASKI
NANCY L. TOMPKINS
TOWNSEND AND TOWNSEND AND CREW LLP
379 Lytton Avenue
Palo Alto, California 94301
(415) 326-2400

Counsel for Respondent

215104

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

QUESTIONS PRESENTED

1. Whether the Federal Circuit correctly held that multiple and unambiguous statements in the common specification of the asserted patents disparaging and differentiating a key feature of the prior art operate to disavow that feature from the scope of the claimed inventions, particularly where the statements do not conflict with the text of the patent claims.

2. Whether, as petitioner conceded below, sweeping disavowals of reliance on "human decision making" to determine final tooth positions, which the applicants made to the Patent Office in order to distinguish cited prior art and thereby win allowance of the parent to the asserted continuation patents, are relevant to the interpretation of the asserted patent claims containing "linking language" relating directly to the disavowed feature.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rule 29.6, Respondent Align Technology, Inc. (Align) avers that it has no parent corporation, and no publicly-held company holds more than ten percent of Align's stock.

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JURISDICTION

The district court was empowered to adjudicate the parties' respective claims and counterclaims for patent infringement under 28 U.S.C. §§ 1331 and 1338(a). The United States Court of Appeals for the Federal Circuit had jurisdiction over the ensuing appeal and cross-appeal under 28 U.S.C. § 1292(c). This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

In aid of its untenable argument that patent claims ought *not* be read in light of the specification, of which they are a part, Ormco Corporation (Ormco) omitted from its petition for *certiorari* the statutory language (in bold type below) that immediately precedes the language it selectively quoted from 35 U.S.C. § 112:

> **§ 112. Specification**
>
> **The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.**
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. . . .

STATEMENT OF THE CASE

In 2003, Ormco Corporation sued Align Technology, Inc. (Align) for infringement of four related patents all directed to the computer-executed design and manufacture of conventional wire-and-bracket appliances to move teeth, *i.e.*, "braces." In arguing for allowance of the first patent in this family (U.S. Patent No. 5,431,562 or "the '562 patent") in the early 1990s, Ormco emphatically distinguished its invention from still-earlier inventions that had applied traditional computer-aided-design (CAD) techniques to designing orthodontic appliances. The traditional techniques, Ormco asserted, merely helped the orthodontist to "model" a desired result by enabling her to manipulate digital images of a patient's teeth into an arrangement the orthodontist deemed optimal. The groundbreaking feature of its invention, Ormco claimed, was the virtual independence from fallible human judgment in the design of orthodontic appliances. Specifically, Ormco claimed to have devised a series of reliable algorithms that a computer could execute, following a simple data-input procedure, to arrive at the optimal final arrangement for any given patient's teeth.

Years after Ormco filed the application leading to the '562 patent—to which each of the asserted patents claims priority[1]—Align developed the Invisalign®

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1. A patent applicant claims a distinct benefit by filing continuation patents that relate back to an earlier "ancestor" patent, as Ormco did here: the continuation patents are accorded (Cont'd)

System, a completely novel approach to straightening teeth.[2] In applying for the most recent of the continuation patents it asserted against Align (U.S. Patent No. 6,616,444 or "the '444 patent"), almost ten years after prosecuting the application that issued as the '562 patent, Ormco wrote markedly broader and more ambiguous claims in a plain attempt to make its earlier invention read on Align's product. By broadening the claims, however, Ormco improperly attempted to recapture subject matter that the patent applicants had expressly disavowed in both the asserted patents' common specification and in the arguments they had made to the Patent Office to win issuance of the '562 patent, the "parent" to all four of the asserted patents, which shares the same specification.

(Cont'd)

the same "priority date," *i.e.*, they are deemed to have been filed on the date the "ancestor" application was filed. Inventions claimed in continuation patents are thus deemed to have preceded any otherwise-invalidating prior art that came into existence between the filing dates of the ancestor and the continuation applications.

2. Align's product and manufacturing process, unlike Ormco's patented process, is not fully automated, but rather relies upon skilled human operators to manipulate digital images and to make decisions about where and how a patient's teeth should move. In addition, Align's Invisalign® appliances are worn by the user for prescribed intervals, not affixed to the teeth, and are made of clear polymeric material, not wire and brackets. Further, Ormco's patents teach the manufacture of a single ideal appliance, whereas the Invisalign® System is comprised of a number of separate appliances used sequentially.

Disparaging Statements In The Asserted Patents' Common Specification

Each of the four[3] patents-in-suit shares a common specification—which Ormco inexplicably omitted from the Appendix to its Petition—which begins by explaining that:

> [a] problem of the prior art that has inhibited the selection or design of an ideal orthodontic appliance for the patient is the difficulty in arriving at an expression of the ideal finish position of the teeth. Orthodontists typically make models of the patient's mouth, and, with the models and the aid of x-rays, determine a treatment to move the teeth to finish tooth positions. This process is time consuming and presents a source of error and inaccuracy. From the measurements and based on the judgment of the orthodontist, appliance components are selected to implement the prescribed treatment. In reality, the treatment of patients is in many cases more of an art than a science, with results ranging from poor to excellent, and generally variable.

Supp. App. 57-58 ('444 patent col.2 l.64-col.3 l.10).

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3. The Federal Circuit affirmed the district court's judgment as to three of the four asserted patents. It reversed and remanded as to select claims from the '444 patent.

The problem, according to the applicants, was the prior art's unavoidable reliance on human judgment, owing to the difficulty of "developing an automated system that includes reliable and efficient decision making algorithms and techniques for automatically determining an ideal finish position of the teeth." Supp. App. 58 ('444 patent col. 3 ll.17-22). Thus, the stated "primary objective of the present invention" was to provide ". . . a practical, reliable and efficient custom appliance automated design and manufacturing system and methods of automatically designing custom orthodontic appliances and treating patients therewith." Supp. App. 58 ('444 patent col.3 ll.41-45). The specification continues: "In accordance with the preferred embodiment of the present invention, there is provided a computerized system and method with which finish positions of the teeth of a patient are derived from digitized information of anatomical shapes of the patient's mouth . . ." Supp. App. 58 ('444 patent col.4 ll.16-20). "The computer . . . at the appliance facility . . . calculates, based on the digitized information..., the final position of the patient's teeth. . . ." Supp. App. 63 ('444 patent col.14 ll.6-8). The patents go on to recite the detailed formulas and algorithms the computer applies in order to arrive at this determination. Supp. App. 76-83 ('444 patent. col. 39 l.41-col. 53 l.52). Following the disclosure of these formulas is the statement: "[a]t this point, the final positions of the maxillary teeth have been calculated, and thus, the finish positions of all of the teeth." Supp. App. 83 ('444 patent col. 53 ll.50-52). As the Federal Circuit noted, "[t]here is no discussion of operator or orthodontist review or adjustment of those

finish positions or of the bases on which such review and adjustment might be made." Pet. App. 10a.

Distinguishing Statements Applicants Made to Secure Allowance of the Parent Patent

As the Federal Circuit determined, the narrow scope of Ormco's claimed inventions was firmly established by definitive statements the applicants had made to the Patent Office to obtain issuance of the '562 patent, the parent to all four of the patents Ormco asserted against Align. The applicants secured allowance of the '562 patent—which shares the same specification as the asserted patents, and to which each of the asserted patents claims priority—through the same combination of disparagement (of the human-involved methods and uncertain results of the prior art) and rhapsody (over the invention's promise of better-aligned teeth through computer-executed math). Originally, the Patent Examiner rejected the claims of the '562 application for obviousness, citing a still-earlier patent (U.S. Patent No. 5,011,405 or "the '405 Patent"), which also claimed a computerized method for designing orthodontic appliances, issued to one Dr. Marc S. Lemchen. In their Response, the applicants overcame the Examiner's rejection by making a number of statements characterizing the Lemchen patent and explaining in very broad terms why their invention was different and better:

> Using such a CAD [computer-aided design] program in a conventional manner, as Lemchen describes, an operator would

> manipulate the tooth images to provide the desired occlusion. This would presumably involve some decision making by the operator. As the operator manipulates the images, the computer, under the control of the conventional CAD program, would perform calculations that would generate data of the tooth movements made by the operator and thus of the finish positions of the teeth. . . . The Lemchen patent relies, to produce the calculations, on the conventional calculation techniques employed in generalized CAD software. *This in turn relies on a user interactive interface by which an operator contributes human decision making powers to manipulate images until the operator is satisfied that finish tooth position criteria have been met. . . . [W]ith conventional CAD programs, the reliance on human decision making is heavy, and rigorous fully automated arrival at tooth finish positions is lacking.*

March 16, 1994, Response to Office Action, p. 49, JA 1323-1324 (emphasis added).

The applicants go on to distinguish their own invention in similarly broad terms:

> The present invention of applicants is directed toward the most complete and fully automated method for orthodontic appliance design and manufacture made. . . . The judgment, or

> decision making, on the acceptability of tooth positions must be imposed externally of Lemchen's system. This leads to human error and inconsistencies from patient to patient. Lemchen does not disclose this being done automatically thereby avoiding such errors and inconsistencies. . . . Therefore, Lemchen . . . uses a user interactive computer system to calculate tooth finish positions, [whereas] applicants have provided a computerized system with the intelligence to decide for itself the best finish positions of the teeth.

Id., JA 1326-1331.

In further support of these arguments to the Examiner to allow the '562 Patent, Ormco submitted a Declaration from Dr. Michael W. Scott, an orthodontist, which states: "In applicants' overall method, it is a computer, not an orthodontist or an orthodontically skilled computer operator that makes the decision on the finish positions in which the teeth are to be placed." March 16, 1994 Supp. Decl. of Scott, pp. 9-10, JA 1378-1379. These statements leave no doubt that the applicants defined Ormco's claimed inventions as excluding manual or human-interactive– as opposed to automated – design of orthodontic appliances.

Align's Summary Judgment Motions

The public record, including the '562 prosecution history and the asserted patents' common specification, establish that Ormco's patented invention is narrow. Accordingly, Align moved the district court for summary

judgment of non-infringement. First, Align argued that the asserted patent claims were necessarily limited to *intelligent and automated* computer systems for designing and manufacturing orthodontic appliances. The district court agreed. Then, since it was undisputed that Align's accused design and manufacturing processes are informed by the judgments of trained operators or orthodontic practitioners,[4] the district court granted Align's motion for summary judgment of non-infringement as to every asserted claim. Next, Align moved for summary judgment that the Ormco patents were invalid as not enabled[5] since, after eleven years of diligent effort, Ormco itself had not succeeded in making a working system as intelligent as that the patents describe and claim. Applying the same claim construction, the district court granted this motion, and invalidated the asserted claims for nonenablement.

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4. Align currently employs more than 500 such trained operators.

5. "[I]t is settled law that a patent is void if the described result cannot be obtained by the described means." *Mitchell v. Tilghman*, 86 U.S. 287, 396 (1873), *overruled on other grounds*. "Enablement requires that the specification teach those in the art to make and use the invention without 'undue experimentation.'" *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991). Those of ordinary skill in the art must be able to make and use the invention "as broadly as it is claimed." *Id.* at 496. Enablement is a legal question based on underlying factual inquiries, and is determined as of the filing date of the patent application. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986).

Ormco's Appeal

On appeal, Ormco argued that the district court had defined Ormco's patent rights "without reference to" the asserted claims. Ormco conceded that in construing the claims the district court was entitled to consider the specification as well as the applicants' statements, such as those quoted above, from the '562 patent's prosecution history. Bl.Br. 42. Ormco asserted, however, that the district court had applied those statements too broadly. In particular, Ormco said the statements from the '562 prosecution history should have been permitted to inform the interpretation of only those patent claims that featured "linking language" inviting reference to those statements. In its opening brief on appeal, Ormco specifically called out claims 37-40, 45 and 69 of the '444 patent as *not* featuring such language. "Those claims," Ormco explained, "are directed to methods of processing digital data about the teeth, not to determining finish tooth positions." Bl.Br. 35.

What is odd about Ormco's present petition is that Ormco prevailed on appeal as to its principal argument. The Federal Circuit, with resort to the full record and applying overlaid *de novo* standards of review—first to the district court's claim construction and second to the district court's summary-judgment determinations—affirmed-in-part and reversed-in-part. *And it did so on the very basis Ormco argued.* The Court of Appeals, in fact, reversed and remanded the judgment as to the very claims Ormco itself had identified as having no "linking language" because the Court agreed those claims lacked any such language inviting reference to the narrowing statements that appeared in the specification or '562 file history.

The Court held that claim terms could be interpreted by reference to statements in the prosecution history of a related patent if there was language in the claims confirming their relation to the subject matter of those statements. Pet. App. 11a. Thus, the Court affirmed the judgment only as to those claims directly related to determining finish tooth positions, the subject matter of the multiple statements quoted above from the specification and the '562 prosecution history. In doing so, it specifically cited the claim language it found to be "linking." Pet. App. 14a. It reversed as to the very claims Ormco distinguished in its opening brief because, as Ormco had pointed out, those claims related to other subject matter, *i.e.*, "the preliminary gathering and organization of tooth data. . . ." Pet. App. 16a. In other words, the Federal Circuit did exactly what Ormco asked it to do: it affirmed only as to the claims whose language directly "linked" them to the inventors' disclaiming statements, and it reversed as to the rest. Ormco is dissatisfied simply because the Federal Circuit, in applying this argument, found "linking language" in more claims than Ormco did.

Ormco's petition for rehearing was denied.

REASONS FOR DENYING THE PETITION

Ormco cannot articulate a question worthy of this Court's review without soft-pedaling the law and the facts that are dispositive of this case. In its bid to persuade the Court that Congress intended patent claims to be construed in a vacuum, Ormco asserts that only one sentence of the Patent Act, defining claims, is "relevant" to understanding the issues presented here. But the entire paragraph that precedes that sentence in the statute defines the *patent specification*, of which the claims are the final part. In similar fashion, Ormco supplies the Court with the bare language of its asserted patent claims, but withholds the 100 pages of text and drawings (*the written description portion of the specification*) that give meaning to those claims. In its petition, Ormco declines even to quote the statements it insists the lower courts misconstrued, and, needless to say, it offers no alternative explanation whatsoever for those statements.

Moreover, Ormco denies the obvious fact that the Court of Appeals did consider the text of Ormco's patent claims both in reversing, in Ormco's favor, with respect to certain claims, and affirming with respect to the rest. Not only that, the Court specifically recited the claim language that impelled its decision. The text of the claims was clearly not disregarded.

Finally, Ormco shrinks from saying outright that the remand it seeks would merely serve to require the district court to reconsider a decision the Court of Appeals has already affirmed-in-part and reversed-in-part upon *de novo* review of the same evidence and

argument the parties presented to the district court – relief that would cost the parties and the courts much time and effort – without likely yielding a different result.

Ormco is plainly unhappy with the Federal Circuit's judgment holding the majority of the patent claims it asserted against Align to be not infringed and not valid. But this is hardly evidence of the Federal Circuit's disregard for this Court's or Congress's authority, as Ormco suggests. In fact, it is Ormco that refuses to acknowledge the true significance this Court and Congress have accorded to the patent specification in construing patent claims, which are *quite different from* laws or statutes. Whereas the Court has shown a preference for construing statutes according to their plain meaning without resort to legislative history, it has shown no hesitation about ascertaining the meaning of a patent's claims, which are part of its specification, by consulting other parts of its specification. To the contrary, this Court has long held that a patent's claims are *always* to be read in light of its specification. And the Federal Circuit has confirmed that the specification, the prosecution history, and the claims together constitute the *intrinsic* record, which district courts *must* consult, in determining the meaning of patent claims. Both this Court and the Federal Circuit have consistently held that it is the properly construed claims (interpreted in view of the intrinsic record) that define the boundaries of the invention. There is no controversy here.

Ormco has described a mild insult to the process it believes it was due: the district court did not hold a formal claim-construction hearing. But, as Ormco knows, the law does not require such a hearing. In fact, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (Fed. Cir. 1995)

(*en banc*), clearly indicates that district courts have the discretion to construe patent claims according to any procedure they deem helpful.[6] In any event, the Court of Appeals reviewed the district court's claim construction *de novo* in view of all the evidence the parties submitted, and ultimately reversed and remanded select claims to be construed anew in the district court.[7] Any possible

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6. As the Federal Circuit explained in *Ballard Medical Products v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1358 (Fed. Cir. 2001):

> *Markman* does not require a district court to follow any particular procedure in conducting claim construction. It merely holds that claim construction is the province of the court, not a jury. To perform that task, some courts have found it useful to hold hearings and issue orders comprehensively construing the claims in issue. Such a procedure is not always necessary, however. If the district court considers one issue to be dispositive, the court may cut to the heart of the matter and need not exhaustively discuss all the other issues presented by the parties. District courts have wide latitude in how they conduct the proceedings before them, and there is nothing unique about claim construction that requires the court to proceed according to any particular protocol. As long as the trial court construes the claims to the extent necessary to determine whether the accused device infringes, the court may approach the task in any way that it deems best.

7. Ormco has taken the position on remand that a claim construction hearing is unnecessary. Joint Status Report of the Parties filed in United States District Court, Central District of California on March 20, 2008, p. 3. Align is completely in the dark as to what advantage Ormco expects to secure by simultaneously making diametrically-opposed arguments to two different federal courts.

procedural slight to Ormco was thus obliterated. Ormco never once suggests that it could or should have won this case on the merits. Having described no procedural and no substantive injury, Ormco has shown no cause to grant the writ.

I. Ormco's Case Does Not Warrant Further Hearing

This Court need not even review the record to confirm that Ormco's chief complaints about the Federal Circuit are false. Since the law does not permit Ormco to argue that it was entitled to a detailed, limitation-by-limitation construction of each of the 92 claims it asserted against Align, Ormco says the Court of Appeals construed the claims without consulting their text, and without reciting the language the Court viewed as inviting reference to the disavowals and disclaimers appearing in the '562 prosecution history and the patents' common specification. But Ormco can only make this claim by ignoring the crux of the Federal Circuit's opinion. In distinguishing among the patent claims whose scope was limited by Ormco's own prior statements, and thus required automation, and those whose scope was not so limited, the Court of Appeals certainly examined and interpreted the individual asserted claims. In fact, it cited, and quoted the "linking language" from, numerous claims to illustrate how they related to the subject matter of the prior statements. Pet. App. 14a-17a. There is no other conceivable basis for its partial reversal, and Ormco suggests none.

A. Courts Are Not Just Permitted, They Are Required, To Consult The Specification In Construing Patent Claims

The law simply provides no traction for Ormco's argument that it was entitled to a claim interpretation uninformed by the lower courts' review of the patents' common specification. (Similarly misguided is Ormco's attempt to deliver this Court from that temptation by excluding the written description of its invention from its Appendix altogether.) There is no conflict in the law on this point. This Court and the Federal Circuit have always encouraged district courts to consider the specification when interpreting patent claim language. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-1316 (Fed. Cir. 2005) (*en banc*) (practice of referring to specification for claim interpretation has "a long pedigree in Supreme Court decisions" dating as far back as 1848). "The claims of a patent are always to be read or interpreted in light of its specifications."[8] *Schriber-Schroth Co. v. Cleveland*

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8. The importance of the specification in claim construction derives from its statutory role [of which Ormco also would keep this Court ignorant]. The close kinship between the written description and the claims is enforced by the statutory requirement that the specification describe the claimed invention in 'full, clear, concise, and exact terms.' 35 U.S.C. § 112, para. 1; *see Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001) ("The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which

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Trust Co., 311 U.S. 211, 217 (1940); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 482, 12 L.Ed. 505 (1848) (the specification is a "component part of the patent" and "is as much to be considered with the [letters patent] in construing them, as any paper referred to in a deed or other contract."). "The descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims." *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985); *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1360 (Fed. Cir. 2004) ("In most cases, the best source for discerning the proper context of claim terms is the patent specification wherein the patent applicant describes the invention."); *see also, e.g., Kinik Co. v. Int'l Trade Comm'n*, 362 F.3d 1359, 1365 (Fed. Cir. 2004) ("The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history."); *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1315 (Fed. Cir. 2003) ("[T]he best indicator of claim meaning is its usage in context as understood by one of skill in the art at the time of invention."); *Merck & Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003) ("A fundamental rule of claim construction is that terms in a patent document are construed with the meaning

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> they arose."); *see also Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996) ("[A claim] term can be defined only in a way that comports with the instrument as a whole.")

Phillips, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*).

with which they are presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part.") (citations omitted).")

Equally weightless is Ormco's complaint that the lower courts turned to the written description portion of the specification prematurely, before they had attempted to construe the claims in a vacuum. That patent claims are assigned primacy under the law does not limit the courts' authority simultaneously to examine other evidence of their meaning. In fact, courts construing patent claims "*must*" review the intrinsic evidence—consisting of the claim language, the specification, and the prosecution history—in its totality. *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1366 (Fed. Cir. 2001) (emphasis added); *see also Computer Docking Station Corp. v. Dell, Inc.*, __ F.3d. __, 2008 WL 752675, *4 (Fed. Cir. Mar. 21, 2008) ("It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, *i.e.*, the patent itself, including the claims, the specification and, if in evidence, the prosecution history."), *quoting Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

The written description portion of the specification, which precedes the claims—and which, in the case of the '444 patent, comprises some 100 pages of text and drawings—is what provides the "full, clear, concise, and exact" description of the invention required by statute. This description precedes the claims in every patent, and gives them meaning. "[T]hey do not have meaning removed from th[is] context . . ." *Netword*, 242 F.3d at

1352; *Standard Oil Co.* 774 F.2d at 452 (because claims are "based on the [written] description, . . . [t]he specification is . . . the primary basis for construing the[m].")

Even the sequence of this presentation (specification concluding with claims) signals that the descriptive text and drawings provide the backdrop against which the claims are interpreted. "The claims [do not] enlarge what is patented beyond what the inventor has described as the invention." *Netword*, 242 F.3d at 1352. Thus, the Federal Circuit has held, "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." *Phillips*, 415 F.3d at 1316 (quoting *Renishaw PLC v. Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)). This holding is perfectly consistent with Congress's and this Court's own pronouncements.

To be sure, courts must take pains not to import into the patent claims as limitations language that is merely intended to characterize a particular disclosed embodiment of the invention, or to read as disavowals general statements appearing in the specification "indicating that the invention is intended to improve upon [the] prior art. . . ." *Ventana Medical Sys. v. Biogenex Labs.*, 473 F.3d 1173, 1181. But Ormco does not even suggest that either of those things happened here. Nor could it.

The present case is in perfect accord with *Ventana*, which holds that claim terms are to be given their ordinary and customary meaning "*unless something in*

the specification or prosecution history reflected the inventor's intent that one of ordinary skill should interpret the claim terms differently." Cert. Pet. 18 (emphasis added). This case illustrates that exception. When Ormco attempted to broaden its patent claims, with the filing of the application leading to the '444 patent, the claims got farther afield from the description provided in the specification. That description could not be altered, however, without jeopardizing the later patent's claim of priority to the ancestor '562 patent. Thus, while, without reviewing the intrinsic record, the '444 patent claims appear broad enough to capture a human-driven design process, the written description makes abundantly clear that Ormco long ago disavowed such a process.

In *Ventana*, the defendant argued that statements in the specification describing the invention's general improvement over the prior art worked as a blanket disavowal of all the described prior art. The Federal Circuit rejected this conclusion, observing first that, if it were correct, then the inventors would have disavowed coverage of a method employed by the patent's preferred embodiment. Here, there is no conflict between what the applicants clearly disavowed and what they plainly claimed.

In addition, the Court in *Ventana* held that such general statements as the inventors made could not be interpreted to disclaim every feature of every prior art device discussed in the patent. *Id.*, 473 F.3d at 1181. Here, the specification does not merely announce a general advance past the prior art, as did the specification at issue in *Ventana*. *Id.*, 473 F.3d at 1181. It expressly

disparages the prior art's approach to "arriving at an expression of the ideal finish position of the teeth," *i.e.*, an orthodontist manipulating (digital or solid) models of the patient's teeth, as "present[ing] a source of error and inaccuracy." Supp. App. 58 ('444 patent col.3 l.4). It attributes the "variable" results of the prior art to the difficulty of "developing an automated system that includes reliable and efficient decision making algorithms and techniques for automatically determining an ideal finish position of the teeth." Supp. App. 58. ('444 patent col.3 ll. 19-22). It announces "a computerized system and method with which finish positions of the teeth of a patient are derived from digitized information of anatomical shapes of the patient's mouth" (Supp. App. 58 ('444 patent col.4 ll.17-21)) by a "computer [which] . . . calculates, based on the digitized information . . . the final position of the patient's teeth." Supp. App. 63 ('444 patent col.14 ll.6-8). And it goes on to describe a simple data-input procedure, Supp. App. 72-76 ('444 patent col.32 l.65-col.39 l.39), followed by a lengthy series of algorithms for a computer to execute in order to discover an optimal final tooth arrangement, Supp. App. 76-83 ('444 patent col.39 l.41-col.53 l. 54).

As important, the specification does *not* describe how an orthodontist exerting her own judgment might go about deciding a final tooth arrangement for herself. It does not even describe how she might perfect or "tweak" the computer's final judgment once the computer has completed the math. The specification, thus, *does not even purport to enable* a process for determining final tooth positions that is manual or utilizes human decision making. It does not support any interpretation for the asserted claims other than the one reached by the

Federal Circuit. *See Kinik Co. v. Int'l Trade Comm'n*, 362 F.3d at 1365 ("The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history.")

Ventana further holds that "when [a] claim addresses only some of the features disclosed in the specification, it is improper to limit the claim to other, unclaimed features." *Ventana*, 473 F.3d at 1181. This is precisely the basis upon which the Federal Circuit in this case reversed the district court's judgment to the extent it did. It determined that the district court had improperly limited certain claims as to features they did not address.

Finally, in *Ventana*, rejecting defendant's prosecution-disclaimer argument, the Federal Circuit explained that "the inventors did not rely on [the allegedly-disclaimed feature] as a distinction between the claims at issue in this case and the prior art." *Id.*, 473 F.3d at 1183. Here, in contrast, that feature, computer-executed versus human-dictated design, is *precisely* the basis upon which the inventors distinguished their patent claims and the prior art.

Simply put, the Federal Circuit followed *Ventana* and other consistent, well-settled claim construction principles in construing Ormco's patent claims. There is no conflict.

B. Ormco Conceded On Appeal That The '562 Prosecution History Was Relevant To The Interpretation Of At Least Some Of The Asserted Claims

Patents in the same family ought to be read consistently with one another, particularly when they share the same specification. "Prosecution disclaimer may [thus] arise from disavowals made during the prosecution of ancestor patent applications." *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1333 (Fed. Cir. 2003); *Jonsson v. Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990). Ormco has admitted that this principle is appropriately applied under certain circumstances.

Here, Ormco conceded on appeal that "[t]he statements from the '562 prosecution history cited by the district court are relevant . . . to the limitation of deriving tooth finish positions from a derived ideal dental archform." Bl.Br. 42. Thus, the gist of Ormco's argument on appeal was not that the claims should be construed in a vacuum, but rather that "Federal Circuit law require[d] *a link* between the claim language at issue in the prosecution history and the language being construed." Bl.Br. 40 (emphasis added).

The Federal Circuit found such a link. Here, the sweeping and specific disclaimers the applicants made to the Patent Office to secure issuance of the '562 patent were perfectly in keeping with the statements they made in the asserted patents' common specification. Moreover, as the Federal Circuit noted, "[n]one of the prior statements . . . were limited to particular claims." Pet. App. 13a. The Federal Circuit nonetheless agreed

with Ormco that "linking language" (or a "linguistic hook") was required to "pull in" the disclaimers the applicants made in prosecuting the parent patent to the interpretation of the offspring patents. But, upon examining the text of the 92 asserted claims, the Court of Appeals determined the majority featured such language. As to the rest, the Court reversed. Ormco's only conceivable complaint is that it does not agree with the decision the Federal Circuit reached after applying the analysis Ormco urged. But mere disagreement with the result is not a proper basis for this Court's review.

C. The Public-Notice Function Of A Patent Is Not Impaired By The Incorporation of Disavowals From the Specification or Disclaimers From the Prosecution History

Ormco suggests the lower courts have impaired the public-notice function of its patent claims by reading obscure limitations from the specification and an unrelated prosecution history into the claims. But this assessment is unsupportable. First, the customary and ordinary meaning of claim terms is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips*, 415 F.3d at 1313. And that person "is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent. . . ." *Id.* Thus, the public notice function can only be served by consideration of the claims, the specification and the prosecution history together – not the claims in isolation.

Second, there was nothing obscure about Ormco's claim to have invented ". . . a practical, reliable and efficient custom [orthodontic] appliance automated design and manufacturing system." Supp. App. 58 ('444 patent col.3 ll.42-43). Neither was there anything obscure about Ormco's disdain for the traditional approach to orthodontic treatment "based on the judgment of the orthodontist" (Supp. App. 58 ('444 patent col.3 ll.5-6)), which, Ormco asserted, was "more of an art than a science, with results ranging from poor to excellent, and generally variable." Supp. App. 58 ('444 patent col.3 ll. 9-10). Placing such pronouncements on the face of a patent is a classic way to disown subject matter from an invention. A skilled artisan reading the specification would understand such a disavowal and would be placed on notice of the narrow scope of the claims.

"[W]here the general summary or description of the invention describes a feature of the invention . . . and criticizes other products . . . that lack that same feature, this operates as a clear disavowal of these other products (and processes using these products)," regardless of the literal language of the claims. *Astrazeneca AB v. Mutual Pharmaceutical Co.*, 384 F.3d 1333, 1340 (Fed. Cir. 2004); *see also SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001) ("Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in

question."); *Honeywell Intern., Inc. v. ITT Industries, Inc.*, 452 F.3d 1312, 1319 (Fed. Cir. 2006) ("It is true . . . that the . . . patent's written description did not expressly define 'electrically conductive fibers . . . Nevertheless, based on the disclosure in the written description, which demeaned the properties of carbon fibers, we conclude that the patentee thereby disavowed carbon fibers from the scope of the [asserted] patent's claims."); *Inpro II Licensing, S.A.R. L. v. T-Mobile USA, Inc.*, 450 F.3d 1350, 1354 (Fed. Cir. 2006) (same).

Third, as noted above, the specification does not even purport to enable a simpler method of arriving at ideal finish tooth positions than the execution by a computer of a series of algorithms. Automation is required, not only because Ormco disavowed reliance on human judgment, but also because the specification does not even begin to describe, let alone in "full, clear, concise, and exact terms," how an orthodontist might make this determination outside of an automated process.

Fourth, the public has full access not just to the claims, but also to the specification and the prosecution history of issued patents. Thus, contrary to Ormco's argument, the public would have been confused and competition thwarted if the courts had read the claims as Ormco urges without reference to this intrinsic evidence, and accorded Ormco a bigger monopoly than the one the Patent Office granted. Here, to the extent there was a public-notice problem, it arose from Ormco's

patent claims, which by themselves are inadequate to put the public on notice as to the limited scope of the patent grant. The Federal Circuit recognized and cured this problem.

> The situation here involves specifications that in all respects tell us what the claims mean, buttressed by statements made during prosecution in order to overcome a rejection over prior art. . . . [T]o attribute to the claims a meaning broader than any indicated in the patents and their prosecution history would be to ignore the totality of the facts of this case and exalt slogans over real meaning.

Pet. App. 14a-15a.

II. Ormco Is Not Entitled To A Different Result

Ormco's real complaint cannot be that the Federal Circuit failed to look at its patent claims. The Federal Circuit clearly did. Ormco's real complaint may be in the result—that, in reviewing Ormco's patent claims, the Federal Circuit found more "linking language" than Ormco was willing to concede was there.

Ormco allowed that "[t]he statements from the '562 prosecution history [quoted above] are relevant" to construing the asserted claims. Bl.Br. 42. But Ormco took the position that the district court should have applied the limitation called for by those statements—automation—only to claims containing the specific

phrase, "deriving a dental arch form or 'deriving' finish tooth positions," because only that language appeared in the statements quoted from the'562 file history. Bl.Br. 45. The Court of Appeals, however, found many other synonymous concepts expressed in the claims at issue, including "producing desired tooth position signals containing digitized data of desired positions of a plurality of the patient's teeth"; "a computer programmed . . . to calculate finish positions of the teeth of the patient"; "determining treatment positions of the teeth"; and "a computer programmed to apply at least some automated tooth position criteria to produce a digital model of the teeth of the scanned shapes in desired positions." Pet. App. 14a. These phrases, the Court held, as well as those Ormco conceded, also invited reference to the '562 file history. The Court thus construed the claims featuring all of this language as describing an automated process. In view of the facts and legal precedents Ormco eschews, and even those upon which it relies, the judgment is unassailable on the merits. Indeed, Ormco has never even suggested a plausible alternative construction for the 86 claims as to which the Federal Circuit affirmed.

Moreover, as this case is fully consistent with the majority decision in *Ventana* and the other decisions Ormco cites, it poses no substantial conflict within the Federal Circuit regarding the use of prosecution history. Ormco simply does not like the result of the Court of Appeals' analysis with respect to the claims found to be affected by the prosecution history.

III. Policy Considerations

Ormco suggests that, by affirming, the Federal Circuit has invited any district court adjudicating a patent case to avoid the claim-construction process by simply divining the "essence of the invention" from the specification. But this is untrue. The Federal Circuit did not endorse a sweeping change in the law of claim construction. The record supported affirmance in this case, and the Court of Appeals saw no reason to remand just to enforce its preference for a procedure the law does not require:

> We accept Ormco's argument . . . that the district court failed to conduct a claim construction in this case focusing on specific claim language, is not lacking in force. However, we review decisions, not opinions, . . . and when we are able to fully comprehend the specification, prosecution history, and the claims and can determine that, to the extent we have indicated, the district court arrived at the correct conclusion, we need not exalt form over substance and vacate what is essentially a correct decision.

Pet. App. 18a.

Ormco's petition for *certiorari* is an exhortation to exalt form over substance. It makes no sense to require the district court to conduct yet another inquiry into the claims' meaning (answering questions of law subject to *de novo* review) when the Federal Circuit has already affirmed the district court's original claim construction

based on the complete appellate record. To require yet another claim-construction process would increase the litigation costs of both parties, waste precious court time and set an expensive precedent in patent litigation, while virtually assuring the same outcome. Ormco is unhappy with the Federal Circuit's decision. But this Court grants review only when a party raises a specific, significant and recurring legal error or a conflict in the law that must be resolved. This case presents no such issue.

CONCLUSION

For all of the foregoing reasons, Ormco's Petition for a Writ of Certiorari should be denied.

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Respectfully submitted,

DANIEL J. FURNISS
Counsel of Record
ANNE M. ROGASKI
NANCY L. TOMPKINS
TOWNSEND AND TOWNSEND AND CREW LLP
379 Lytton Avenue
Palo Alto, California 94301
(415) 326-2400

Counsel for Respondent

Supplemental Brief Unavailable for Filming at this Time